

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

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### **PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. This document proposes amendments to the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”). More specifically, these proposals concern amendments to Rules 3, 5, 5*bis*, 22, 24 and 39 of the Regulations and consequential amendments to the Schedule of Fees.
2. The COVID-19 pandemic has resulted in severe disruptions for users of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) due to measures taken in several countries to combat its spread. Those disruptions have made evident that the safeguards provided for in the Regulations present a number of deficiencies.
3. To address the above-mentioned deficiencies, the proposed amendments to Rule 5 of the Regulations seek to provide users of the Madrid System with safeguards aligned with those found in the Regulations under the Patent Cooperation Treaty (hereinafter referred to as “the Regulations under the PCT”), which are broader in nature. The other proposals further support the ongoing process of simplifying the Regulations, streamlining the processes under the Madrid System and making it more user-friendly to its users, Offices of Contracting Parties and interested third parties. The proposals are reproduced in the Annex to this document.

4. It is to be noted that this document has been revised to take into account the fact that the Madrid Union Assembly, at its fifty-fourth session held in Geneva from September 21 to 25, 2020, adopted amendments to Rules 3, 9, 25 and 36 of the Regulations. Those amendments will require that the applicant, in an international application, the new holder, in a request for the recording of a change in ownership, and a newly appointed representative indicate each their electronic mail address to receive electronic communications from the International Bureau. The said amendments will enter into force on February 1, 2021<sup>1</sup>.

## **REPRESENTATION BEFORE THE INTERNATIONAL BUREAU**

### **(A) APPOINTMENT OF A REPRESENTATIVE**

5. The Regulations give holders the possibility to appoint a representative in a separate communication to the International Bureau, in a subsequent designation or in any request under Rule 25 of the Regulations.

6. When holders appoint a representative in a separate communication, the International Bureau records this appointment as a distinct transaction. However, when holders make the appointment in a subsequent designation or in a request, the International Bureau records that appointment as part of the inscription concerned. As a result, the various Madrid System information services available (e.g., Madrid Monitor, Madrid Real-Time Status) display the recording of the appointment of a representative in a manner that is neither consistent nor transparent.

7. There are operational issues when holders appoint a representative in a subsequent designation or in a request. Where the subsequent designation or request is irregular, the recording of the appointment is unnecessarily delayed, which may inconvenience holders and representatives, in particular, where the appointment concerns several international registrations.

8. Holders can now use the Contact Madrid online service to upload optional form MM12 to appoint a representative, which the International Bureau can process within the shortest delay. In addition, the International Bureau plans to make available Web services that will provide for the almost immediate recording of such appointment. To facilitate this development, the Regulations could require that holders appoint a representative in a separate communication. Therefore, it is proposed to amend Rule 3(2)(a) to eliminate the possibility that holders appoint a representative in a subsequent designation or in a request under Rule 25, other than the new holder in a request for the recording of a change in ownership. The proposed amendment would not prevent the applicant from appointing a representative in the international application.

### **(B) CANCELLATION OF THE APPOINTMENT OF A REPRESENTATIVE**

9. Rule 3(6)(d) of the Regulations requires that the International Bureau send applicants or holders copies of all communications with a representative who has requested that the appointment be cancelled, exchanged within the six months preceding the date on which the International Bureau notifies the applicant or holder of the said request.

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<sup>1</sup> See document MM/A/54/1 "COVID-19 Measures: Making E-mail a Required Indication".

10. The above-mentioned provision is unnecessary because applicants and holders can now retrieve all communications concerning an international application or registration through the Madrid Portfolio Manager. In addition, documents concerning decisions sent by Offices are available on Madrid Monitor and bibliographical data and the status of all requests is available on Madrid Real-Time Status. Therefore, it is proposed that Rule 3(6)(d) of the Regulations be amended by deleting the requirement to send the above-mentioned communications.

## EXCUSE IN DELAY IN MEETING TIME LIMITS

11. Rule 5(1) and (2) of the Regulations was first introduced in the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, which entered into force on April 1, 1996. That Rule was modeled on Rule 82 of the Regulations under the PCT, as in force from July 1, 1992<sup>2</sup>.

12. Rule 82 of the Regulations under the PCT dealt separately with two distinct situations, namely, delay or loss of a communication sent through mail or delivery services (in Rule 82.1)), and interruptions in postal or delivery services due to war, revolution, civil disorder, strike, calamity or other like reason (in Rule 82.2)).

13. On July 1, 2012, Rule 82.2) of the Regulations under the PCT was abolished and a new Rule 82*quater* entered into force excusing delays in meeting a time limit to perform an action due to war, revolution, civil disorder, strike, natural calamity or other like reason<sup>3</sup>. Under Rule 82*quater*, the party concerned must provide relevant evidence, to the satisfaction of the International Bureau, and perform the action not later than six months from the date on which the time limit expired. On July 1, 2016, an amended version of this Rule entered into force specifying a general unavailability of electronic communication services as one of the reasons for excusing a delay in meeting a time limit<sup>4</sup>.

14. In contrast, Rule 5 of the Regulations excuses delays in meeting a time limit for a communication addressed to the International Bureau due only to irregularities in postal and delivery services resulting from *force majeure* events, and requires that the interested party meet certain conditions and provide evidence thereof. The same applies for communications sent electronically where there is a failure in the electronic communication services of the International Bureau or in the locality of the interested party.

15. It is proposed that Rule 5 of the Regulations be amended to give users of the Madrid System relief equivalent to that provided for in the Regulations under the PCT. An amended paragraph (1) would introduce the general principle that failure to meet a time limit specified in the Regulations for performing an action before the International Bureau may be excused where the interested party provides evidence, to the satisfaction of the International Bureau, that such failure was due to a *force majeure* event.

16. Paragraph (1) of Rule 5 of the Regulations would apply to any action before the International Bureau for which the Regulations prescribe a time limit, such as, for example, sending a communication, remedying an irregularity or paying a prescribed fee. The International Bureau could waive the evidentiary requirement for widely recognized instances of *force majeure*, as it has done in respect of the COVID-19 pandemic.

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<sup>2</sup> See document PCT/A/XVIII/2 "Proposed Amendments to the Regulations Under the PCT" ([https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_xviii/pct\\_a\\_xviii\\_2.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_xviii/pct_a_xviii_2.pdf)).

<sup>3</sup> See document PCT/A/42/2 "Proposed Amendments of the PCT Regulations" ([https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_42/pct\\_a\\_42\\_2.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_42/pct_a_42_2.pdf)).

<sup>4</sup> See document PCT/A/47/4 "Proposed Amendments to the PCT Regulations" ([https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_47/pct\\_a\\_47\\_4\\_rev.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_47/pct_a_47_4_rev.pdf)).

17. An amended paragraph (2) of Rule 5 of the Regulations would clarify that irregularities in postal, delivery and electronic communication services beyond the control of the interested party and preventing this party from meeting a time limit are deemed *force majeure* events for the purposes of paragraph (1). Paragraph (2) would apply regardless of the place in which the said irregularities occur. It could apply, for example, during disruptions in global postal, delivery or electronic communication services. It is further proposed that paragraph (3) be deleted, as it would no longer be necessary.

18. Such proposed amendments would be helpful for users of the Madrid System who are faced with any *force majeure* situation preventing them from taking the required action within the specified time limit. During the previous decade, the proposed new Rule could have been invoked, for example, in relation to the eruption of the Eyjafjallajökull volcano, in 2010; the earthquake and tsunami in Japan, in 2011; the northern Italy earthquakes and hurricane Sandy, in 2012; the typhoons Hagupit, in 2014; and, hurricane María, in 2017.

19. As it is the case with Rule 82*quater* of the Regulations under the PCT, an amended paragraph (4) of Rule 5 of the Regulations would require that the party perform the action as soon as reasonably possible and not later than six months from the expiry of the time limit concerned. Finally, it is proposed that the title of this Rule be amended to “Excuse in Delay in Meeting Time Limits,” which would better reflect the new scope of the amended Rule.

## **CONTINUED PROCESSING**

20. Rule 5*bis* of the Regulations provides for continued processing as a remedy when applicants or holders miss a given time limit that would result in the abandonment of the international application or of a request. It is proposed that this remedy be made available where the applicant has missed the time limit specified in Rule 12(7) to pay the fees resulting from a classification proposal made by the International Bureau. Further, it is proposed that it be made available where the holder has missed the time limit specified in Rule 27*bis*(3)(c) to pay the fee for a request for division under this Rule. For that purpose, Rule 5*bis*(2) would be amended accordingly.

## **NOTIFICATION RELATING TO CEASING OF EFFECT**

21. The second sentence in Rule 22(1)(c) of the Regulations still refers to the judicial actions or proceedings referred to in paragraph (b). However, this paragraph no longer refers to judicial actions or proceedings. For the sake of consistency, it is proposed that the second sentence in Rule 22(1)(c) be amended by removing the reference to judicial actions and by changing the noun proceedings to the singular mode (i.e., to proceeding).

## **SUBSEQUENT DESIGNATION**

22. Rule 24(3)(a)(ii) of the Regulations requires that holders indicate their address in a subsequent designation, which seems unnecessary. Furthermore, in some subsequent designations, holders indicate an address different than the one appearing in the International Register, which results in an irregularity that delays the recording of the subsequent designation. Therefore, it is proposed that the above-mentioned Rule be amended by deleting the requirement that the subsequent designation contain or indicate the address of the holder.

## **CONTINUATION OF EFFECTS**

23. Rule 34(1) of the Regulations states that the amounts of the fees due under the Protocol or the Regulations are specified in the Schedule of Fees; yet, in an apparent contradiction, Rule 39(1)(ii) specifies the amounts of the fees to be paid for a request that an international registration continue its effects in a successor State.

24. Therefore, for the sake of consistency, it is proposed that Rule 39(1)(ii) of the Regulations be amended by deleting the amounts of the above-mentioned fees and replacing them with a reference to the Schedule of Fees. Further, it is proposed that the Schedule of Fees be amended by introducing new items 10.1 and 10.2 to specify the said amounts.

25. Finally, also for the sake of consistency, it is proposed that Rule 39(1)(ii) of the Regulations be amended to indicate that the International Bureau would transfer the amounts collected to the Contracting Party concerned and not to its Office. The proposed amendments would not substantively change the Rule nor the amounts of the fees for the request.

## **IMPLICATIONS FOR OFFICES AND FOR THE INTERNATIONAL BUREAU**

26. The amendments to the Regulations proposed in the present document concern requests filed with and processed by the International Bureau. Therefore, they would not have an impact on the information technology (IT) systems and operations of the Offices of the Contracting Parties.

27. The International Bureau would change its IT systems to no longer require the address of the holder in a subsequent designation. The International Bureau would develop the changes with internal resources, within its regular operating budget. The changes could be ready for their implementation shortly after the adoption of the proposed amendments.

28. The proposed amendments to the Regulations concerning representation before the International Bureau, excuse in delay in meeting time limits and continued processing would only require changes to the internal processes and practices of the International Bureau. The other proposed amendments, namely, those concerning notifications relating to ceasing of effect and continuation of effects would not have any implication because they would simplify and improve the Regulations without bringing about any substantive change.

## **DATE OF ENTRY INTO FORCE**

29. As indicated earlier, the COVID-19 pandemic has resulted in severe disruptions for users of the Madrid System that are likely to continue for some time in several regions of the world. At the time this document was revised, numerous countries still had measures in place to protect the population from the effects of the pandemic; other countries were facing a likely second wave of infections and reintroducing such restrictions.

30. For the foregoing reason, there is a need for the proposed amendments to enter into force without delay, in particular the amendment to Rule 5 of the Regulations, with a view to protect the interests of the users of the Madrid System. Therefore, it is suggested that the International Bureau recommend to the Madrid Union Assembly that the amendments described above enter into force two months following their adoption.

31. *The Working Group is invited to:*
- (i) consider the proposals made in this document;*
  - (ii) recommend to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations, as presented in the Annex to this document or in amended form, for their entry into force two months following their adoption.*

[Annex follows]

# PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

## Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2020~~ February 1, 2021

### **Chapter 1** **General Provisions**

[...]

### **Rule 3** **Representation Before the International Bureau**

[...]

#### *(2) [Appointment of the Representative]*

- (a) The appointment of a representative may be made in the international application ~~or in a subsequent designation~~ or by the new holder of the international registration in a request under Rule 25(1)(a)(i) and shall indicate the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the representative.

[...]

#### *(4) [Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

- (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name, address and electronic mail address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, ~~subsequent designation,~~ request or separate communication in which the representative is appointed.

[...]

[...]

#### *(6) [Cancellation of Recording; Effective Date of Cancellation]*

[...]

- (d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, ~~and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.~~

[...]

## Rule 5

### **Irregularities in Postal and Delivery Services and in Communications Sent Electronically**Excuse in Delay in Meeting Time Limits

- (1) [~~War, Revolution, Civil Disorder, Strike, Natural Calamity or Other Force Majeure Reason~~ Communications Sent Through a Postal Service] Failure by an interested party to meet a time limit specified in the Regulations to perform an action before~~for a communication addressed to the International Bureau and mailed through a postal service~~ shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that such failure was due to war, revolution, civil disorder, strike, natural calamity or other force majeure reason.
  - (i) ~~that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,~~ [Deleted]
  - (ii) ~~that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and~~ [Deleted]
  - (iii) ~~in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.~~ [Deleted]
- (2) [~~Communications Sent Through~~ Irregularities in Postal, Delivery or Electronic Communication Services] Failure by an interested party to meet a time limit for a ~~communication addressed to the International Bureau and sent through a delivery service~~ shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, Irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party and preventing such party from meeting a time limit specified in the Regulations are deemed force majeure reasons in accordance with the preceding paragraph.
  - (i) ~~that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and~~ [Deleted]
  - (ii) ~~that details of the sending of the communication were recorded by the delivery service at the time of sending.~~ [Deleted]
- (3) [~~Communication Sent Electronically~~] Failure by an interested party to meet a time limit for a ~~communication addressed to the International Bureau and submitted by electronic means~~ shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, ~~that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.~~ [Deleted]



- (4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence and action referred to in paragraph (1), ~~(2) or (3) and the communication or, where applicable, a duplicate thereof~~ are received by and performed before the International Bureau as soon as reasonably possible and not later than six months after the expiry of the time limit concerned.

[...]

#### **Rule 5bis** **Continued Processing**

- (1) *[Request]*

- (a) Where an applicant or holder has failed to comply with any of the time limits specified or referred to in Rules 11(2) and (3), 12(7), 20bis(2), 24(5)(b), 26(2), 27bis(3)(c), 34(3)(c)(iii) and 39(1), the International Bureau shall, nevertheless, continue the processing of the international application, subsequent designation, payment or request concerned, if:
- (i) a request to that effect, signed by the applicant or holder, is presented to the International Bureau on the official form; and
  - (ii) the request is received, the fee specified in the Schedule of Fees is paid and, together with the request, all of the requirements in respect of which the time limit concerned applied are complied with, within two months from the date of expiry of that time limit.

[...]

[...]

#### **Chapter 4** **Facts in Contracting Parties Affecting International Registrations**

[...]

#### **Rule 22** **Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration**

- (1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

- (c) Once the proceeding referred to in subparagraph (b) has resulted in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the ~~judicial action or proceedings~~ referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

[...]

**Chapter 5**  
**Subsequent Designations; Changes**

**Rule 24**  
**Designation Subsequent to the International Registration**

[...]

(3) *[Contents]*

(a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

[...]

(ii) the name ~~and address~~ of the holder,

[...]

[...]

**Chapter 9**  
**Miscellaneous**

**Rule 39**  
**Continuation of Effects of International Registrations in Certain Successor States**

(1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that the Protocol is applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

[...]

(ii) the payment to the International Bureau, within the same time limit, of ~~a~~ the fee of 41 Swiss francs specified in item 10.1 of the Schedule of Fees for the International Bureau, and of the fee specified in item 10.2 of the Schedule of Fees, which shall be transferred by the International Bureau to ~~the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.~~

[...]

## Schedule of Fees

as in force on ~~February 1, 2020~~ [February 1, 2021](#)

*Schedule of Fees*

*Swiss francs*

[...]

### 10. Continuation of Effects

10.1 Fee for the International Bureau 23

10.2 Fee to be transferred by the  
International Bureau to the successor  
State 41

[End of Annex and of document]